

## **REMARKS**

Claims 1, 3-5, 7-18, and 36-40 are currently pending in this application. Claims 1, 3, 5, 7-10 are amended herewith. Claim 41-43 were added. No new matter was added to the amended claims, support for amendments may be found in the cancelled claims, and on pages 2, 3, and 9 of the application.

### **In the Office Action**

[c]laims 1-6, 17, 18, 39, and 40 are rejected under 35 U.S.C. 102 (b) as anticipated by or in the alternative, under 35 U.S.C. 103 (a) as obvious over Lupi (Pat no. 5,755,462) in view of Foote et al (Patent no. 6,036,231). Lupi discloses a packaging for housing at least one prescription product manufactured by a manufacturer and prescribed by a doctor on behalf of the prescription manufacturer. Customized and non-customized graphics are provided by the manufacturer including printed material related to the medication, and ample space for printed promotional indicia on behalf of the prescription manufacturer are also provided, see the abstract.

The customized graphics are provided on at least some surface area of the packaging, the customized graphics being 16a "preprinted physician's information for enhanced prestige and identification afforded to the prescribing medical practitioner", column 2, lines 62 & 63. Hence Lupi discloses the subject matter as claimed where the preprinted physician's information is taken to correspond to the customized graphics consisting essentially of print produced by at least one printer.

Applicants respectfully traverse the rejection of the claims under 35 U.S.C § 102 (b) for the following reasons.

As defined by Claim 1 Applicants' invention is a packaging for a contact lens having an identification means and customized graphics that are selected by the prescribing doctor or the patient, wherein the customized graphics are specified at the time an order for the lenses is placed and the packaging is shipped from the manufacturer containing said customized graphics and said identification means. See claim 1, currently amended. In order for a single reference to anticipate a claimed invention each and every element of the claimed invention must be found in that reference. Applicants respectfully submit that neither reference (Lupi or Foot) anticipate Applicants' claimed invention.

Lupi teaches a "removable medical prescription form [that] is attached to a

second portion of the front surface of a support panel." See Lupi col. 1, lines 57-58. Further, the packaging of Lupi is used to distribute small quantities of a medication in pill, tablet or capsule form. See, Lupi col 1, lines 55-56. Still further, Lupi's removable medical prescription form is reusable and does not contain an identification means as required by Applicants claimed invention. Lupi does not teach a packaging for a contact lens, customized graphics that are specified by the patient or the doctor at the time the order is placed, or an identification means (as defined in U.S. Pat. App. No. 09/494,859, page 3, lines 32-41). Further Lupi does not teach that the packaging is shipped from the manufacturer containing the customized graphics and the identification means. Therefore Lupi does not anticipate Applicants' invention as defined by claim 1. Applicants respectfully request that the rejection of claims 1-5, 17, 18, 39, and 40 under 35 U.S.C § 102 (b) in view of Lupi be withdrawn.

With respect to Foote, that reference teaches a multi-part blank which can be fed in a computer driven printed and when printed, will contain all of the parts needed for a complete set of labels required for a prescription product. See, Foote columns 1-2, lines 66-43. Further, Foote teaches the preparation and application of such multi-part labels at a pharmacy and not at the manufacturer. See, Foote col. 3, lines 8-37. Foote does not teach a packaging for a contact lens, customized graphics that are specified by the patient or the doctor at the time the order is placed, or an identification means. Therefore Foote does not anticipate Applicants' invention as defined by claim 1. Applicants respectfully request that the rejection of claims 1-5, 17, 18, 39, and 40 under 35 U.S.C § 102 (b) in view of Foote be withdrawn.

With respect to the rejection of the claims under 35 U.S.C § 103(a), Applicants respectfully traverse the rejection of the claims as obvious over Lupi in view of Foote following reasons.

First, Lupi and Foote are not analogous art with respect to each other. Lupi discloses and suggests a reusable packaging that contains a prescription pad wherein this reusable packaging is sent directly to a physician for purposes of dispensing and prescribing a pill, tablet, or capsule. Foote discloses and

suggests the preparation and application of a multi-part labels to prescription products that are dispensed from a pharmacy. In order to combine references those references must be of analogous art or there must be some suggestion in the references themselves to combine those references. There is no suggestion in Lupi that the pre-printed information is printed on a label and subsequently adhered to the reusable packaging. Further in Foote, there is no suggestion that the labels are printed anywhere other than a pharmacy prior to dispensing the medication. Without such suggestions in the references themselves, the combination of these reference is impermissible hind-site and inappropriate to support a rejection under 35 U.S.C § 103 (a).

Second, neither Foote nor Lupi suggest all of the elements of Applicant's claimed invention. Neither reference suggest an identification means or that the customized graphics are specified by the patient. Neither reference suggests its use for contact lenses; and neither reference suggests the shipment of contact lenses from the manufacture with the customized graphics and the identification means. Since the references do not suggest all elements of the claims, the combination of those references would not suggest Applicants' claimed invention to one of ordinary skill.

Third, in the Office Action, the rejection under 35 U.S.C § 103(a) was justified by saying that it is "inherent and necessarily required to specify the graphics any time prior to shipment." However, Foote discloses the printing and application of its labels at a pharmacy and not at the manufacturer, as required by Applicants' claimed invention. In Lupi, although some preprinted information is supplied by the manufacturer with the removable prescription form, the physician who is prescribing the medication must add the prescription, the patient's name and other information to the form prior to dispensing the form to a patient. However, since both references add information at separate times and Applicants' invention adds customized graphics and identification means to the contact lens packaging at a third time, the timing of printing is one issue that distinguishes Applicants' invention from Lupi and Foote.

Fourth, in the Office Action, the rejection under 35 U.S.C § 103(a) was justified by two statements: (i) "the preprinted physician's information is taken to correspond to the customized graphic consisting essentially of print produced by at least on printer;" and (ii) "alphanumeric characters, pictures, photographs, ... would have been an obvious matter of design choice." See, Office Action pgs 2-3 citing Lupi column 2, lines 62-63 and Office Action pg. 3, respectively. However Lupi does not suggest the composition of this pre-printed information and Foote only suggests using the doctor's name (see, Foote Fig. 4), neither Foote nor Lupi suggest the customized graphics disclosed by the Applicant, (e-mail address website, street address, appointment information greeting, a picture of the doctor and the like). See, U.S. App. No. 09/494,859 page 2, lines 35-42. Therefore, the assertion that these particular graphics are an obvious design choice is impermissible hindsight. Applicants respectfully submit that the rejection of the claims 1-5, 17, 18, 39, and 40 under 35 U.S.C § 103(a) citing Foote in view of Lupi has been overcome and should be withdrawn.

#### In the Office Action

[c]laims 1, 7-16 and 36-38 are rejected under 35 U.S.C § 103(a) as being unpatentable over European document EP 0734 957 A1 in view of Lupi (Patent no. 5,755,462). European document EP 0 734 957 A1 to Johnson & Johnson discloses a packaging for a prescription product such as a contact lens, comprising a primary package and a secondary package as shown in figure 1-8. The difference between the claimed subject matter and European document EP 0 734 957 A1 to Johnson & Johnson resides in customized graphics present that promotes a return visit to the doctor or advertises for the doctor. EP 0 734 957 A1 discloses that inner containers 10, 12 are provided with "specific orders from a prospective user", and cartons "may be customized prior to filling", col. 8, lines 41-43. *assertions from Lupi were discussed above and are omitted.*

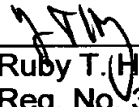
Applicants respectfully traverse this rejection for the following reasons.

EP 0 734 957 A1 discloses contact lens packages containing a printed lidstock. However, there is no suggestion in the document that customized graphics should be added to these packages. Further, even though there is language that refers to customization, that only refers to the content of the orders

and not to the markings on the packaging. See, EP 0 734 957 B1, col. 8, lines 39-41; col. 5, lines 40-43; cols. 8-9 lines 57-7. Lupi does not suggest all of the elements of Applicants claimed invention, namely, contact lens packaging, an identification means, customized graphics specified by the patient, the shipment of contact lenses from the manufacture with the customized graphics and the identification means. Therefore, the combination of Lupi and EP 0 734 957 would not suggest Applicants' invention to one of ordinary skill. Applicants respectfully submit that the rejection of claims 1, 7-16 and 36-38 under 35 U.S.C § 103 (a) in view of Lupi and EP 0 734 957 has been overcome and should be withdrawn

In light of the foregoing election, Applicants submit that all pending claim are in condition to issue. A notice of allowance is respectfully solicited. If the Examiner believes that an interview would expedite the disposition of this case, the Examiner is invited to call the undersigned agent at (732) 524-1024.

Respectfully submitted,

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